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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,011	03/12/2001	Yoshinori Sekine	010320	7342

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EXAMINER

LEE, EDMUND H

ART UNIT PAPER NUMBER

1732

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,011

Applicant(s)

SEKINE, YOSHINORI

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claim 5 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 1/20/04.

2. Applicant's election without traverse of claims 1-4 in Paper No. 1/20/04 is acknowledged.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-81874 in view of Reisser et al (USPN 5332767). In regard to claim 1, JP 64-81874 teach an ink used for printing of a preprinted film or sheet including a binder comprising a polycarbonate resin (abstract); and carbon black surface-treated with one or two or more of polyamine and/or modified polyamine (abstract). JP 64-81874 does not teach using a metal particle. Reisser et al teach a synthetic resin-coated metal pigment which can be used in an ink (col 1, lns 1-13; col 3, lns 3-8); and using aluminum coated with a resin (col 4, ln 63-col 5, ln 5). JP 64-81874 and Reisser et al are combinable because they are analogous with respect to ink containing a resin-coated pigment. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the metal particles of Reisser et al for the carbon black of JP 64-81874 in order to diversify the aesthetic appearance of the ink. In regard to claims 2-3,

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JP 64-81874 does not teach a flat form of aluminum particle; and a flat form of aluminum particle coated on its surface with an acrylic resin. In regard to a flat form of aluminum particle, the above combination of JP 64-81874 and Reisser et al teach an aluminum particle. The specific use of a flat form of aluminum particle is a mere obvious matter of choice dependent on the material availability. Further, metal pigments having a flat form are well-known in the pigment art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a flat form of aluminum particle in the ink of JP 64-81874 (modified) in order to diversify the aesthetic appearance of the ink. In regard to a flat form of aluminum particle coated on its surface with an acrylic resin, the above combination of JP 64-81874 and Reisser et al teach an aluminum particle coated with an acrylic resin. The specific use of a flat form of aluminum particle is a mere obvious matter of choice dependent on the material availability. Further, metal pigments having a flat form are well-known in the pigment art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a flat form of aluminum particle in the ink of JP 64-81874 (modified) in order to diversify the aesthetic appearance of the ink.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-81874 in view of Reisser et al (USPN 5332767). JP 64-81874 teach a printed film or sheet having an ink used for printing of a preprinted film or sheet thereon wherein the ink includes a binder comprising a polycarbonate resin and carbon black surface-treated with one or two or more of polyamine and/or modified polyamine (abstract; pg 3, second column, second paragraph). JP 64-81874 does not teach using a metal particle.

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Reisser et al teach a synthetic resin-coated metal pigment which can be used in an ink (col 1, Ins 1-13; col 3, Ins 3-8); and using aluminum coated with a resin (col 4, In 63-col 5, In 5). JP 64-81874 and Reisser et al are combinable because they are analogous with respect to ink containing a resin-coated pigment. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the metal particles of Reisser et al for the carbon black of JP 64-81874 in order to diversify the aesthetic appearance of the ink.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanck (USPN 3806458) teaches a developer mixture having acrylic coated metal particles.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732


4/5/04

EHL